

Attorney Docket No. 25341A

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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SEP 28 2006

In re Patent Application of)
Jerry H. C. Lee et al.)
Serial No.: 10/826,207) Group Art Unit: 1771
Confirmation No. 1155)
Filed: April 16, 2004) Examiner: M. Matzek
For: Roof Coverings Having Improved)
Tear Strength)

DECLARATION OF DAVID R. JONES, IV
UNDER 37 CFR 1.132

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

I, David R. Jones, IV, hereby state as follows:

**EXPERTISE IN FIELDS OF ASPHALT-BASED ROOF COVERINGS
AND ASPHALT-BASED PAVING COMPOSITIONS**

1. I am a co-inventor of the above-captioned patent application relating to asphalt-based roof coverings. I also have seven issued patents in the areas of asphalt-based roof coverings and asphalt-based paving compositions.
2. I received a B.S. degree in Basic Sciences from New Mexico Institute of Mining and Technology University in 1972, an M.S. degree in Chemistry from The University of Missouri in 1974, and a Ph.D. degree in Chemistry from The University of Missouri in 1976.
3. In 1984, after eight years as an Analytical Chemist, I was made supervisor of the Asphalt Technology Lab at Owens Corning, and entered the field of asphalt chemistry and product development. I supervised eight Ph.D. Chemists charged with developing asphalt products and asphalt technology, including asphalt-based roof

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SEP 28 2006

No. 6299 P. 4

Attorney Docket No. 25341A

coverings and asphalt-based paving compositions. In 1987 I began working in the field of asphalt emulsions with Nobel Industries of Sweden. I was in charge of product development and chemicals supply for Nobel's emulsion business worldwide. I developed emulsion chemistries and product formulations to support Nobel's highway paving businesses. In 1989 I joined the University of Texas as part of the oversight management contract for the \$150 million Strategic Highway Research Program (SHRP), a federally-funded five-year program to revolutionize the materials and technologies used in maintenance and construction of America's Highways. During the SHRP program I was tasked with responsibility for technical management of the five asphalt chemistry programs within the program. In 1993 the SHRP issued a series of new specifications for the purchase and construction of bituminous pavements. These specifications have subsequently been adopted by all 50 States and several foreign countries. Following the SHRP program I joined PRI Asphalt Technologies, and for six years was the Vice President of that organization, running the paving asphalt part of the business. Since leaving PRI in 1999 I have worked for the Trumbull Division of Owens Corning as Technical Program Manager, working on development and sourcing of asphalt products such as asphalt-based roof coverings and asphalt-based paving compositions.

4. During this period I have served as an expert witness in the field of asphalt technology in several court venues, including State District Courts in Ohio and Colorado and Federal Courts in Florida, Ohio, and Montana. I have published twenty-nine papers, and made over one hundred and fifty presentations to technical groups and organizations.

THE MARZOCCHI ET AL. AND WILLIAMS ET AL. PATENTS

5. I have read and understand U.S. Patent No. 4,265,563 to Marzocchi et al. In the Advisory Action, the Examiner stated that Miller and Marzocchi et al teach asphalt covered fiberglass building materials. It is my expert opinion that one skilled in the art would not categorize a paving material as a building material as recited by the Examiner, as they are from different fields of endeavor. One skilled in the art does

Attorney Docket No. 25341A

not generally construct a building from an asphalt paving material, nor would one generally construct a road directly from a roofing material, and one seeking to solve a building materials problem would not look to the paving field to do so. Accordingly, they are from different fields of endeavor.

6. Furthermore, the differences in structure and function of the inventions to a road are significant. As noted in my previous declaration, the construction of each is significantly different – so much so that one cannot perform the relevant standardized tests on the materials in Marzocchi. The examiner cites Marzocchi col. 2, lines 12-16 as showing the use of glass fibers in asphalt. While this is literally correct, it does not motivate one to use glass fibers in paving, and as described in lines 15-20, Marzocchi teaches away from the use of fibers in paving, since there are “no extensively accepted commercial products”. Marzocchi further teaches at column 8, lines 1-17, that fibers are undesirable in paving, and limits the length of desirable fibers to less than 1/64 of an inch –which, as noted in my previous declaration would not provide the mat properties as claimed because such small size pieces would not hold together as a mat with any significant tensile strength. Finally, Marzocchi tells of a trial using glass fibers in paving that was unsuccessful (ref. col. 2, lines 28-52) where Marzocchi states that if you do use fibers, they will be broken, and that if a mat is used, it will be ineffective in paving because of the forces. The pavement of Marzocchi is made from asphalt, large aggregate and glass flakes, while the invention is made from long fibers made into a mat and coated with asphalt. The Marzocchi pavement is exposed to high compressive forces, unlike a roofing mat. Accordingly, because of the structural and functional differences, they are from different fields of endeavor.

7. I have read and understand U.S. Patent No. 4,210,459 to Williams et al.. In the Advisory Action, the Examiner stated that Miller and Williams et al teach composites comprising fiberglass in organic matrices. It is my expert opinion that one skilled in the art would not categorize a roofing shingle as a composite fiberglass in an organic matrix; conversely, one skilled in the art considers a fiberglass roofing shingle as a fiberglass mat coated with asphalt, as the tensile strength is primarily achieved from the fiberglass mat. Conversely, the composites taught in Williams et al comprise (Ref.

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Sep. 28, 2006 5:26PM No. 6299 P. 6
SEP 28 2006

Attorney Docket No. 25341A

col. 19, lines 61-65) filled-vulcanized rubber articles such as tires, gaskets, hoses and other conventional mechanical rubber goods. In my expert opinion, one skilled in the roofing art would not look to rubber goods as being in the same field of endeavor. Furthermore, the structure and function are significantly different, as the matrices of Williams provide significant mechanical strength properties, unlike the asphalt in a roofing shingle. Accordingly the Williams matrix serves to provide strength, while asphalt in a roofing shingle primarily serves as waterproofing, and not a structural member. Accordingly, because of these differences, the references are from different fields of endeavor.

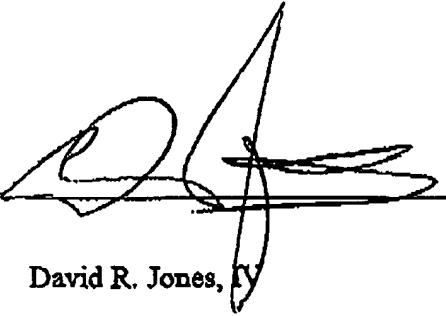
8. I maintain my additional positions set forth in my previous Declaration.

CERTIFICATION AND OATH

I hereby declare that all statements made herein of my own knowledge are true, and that all statements made on information and belief are believed to be true; and further that these statements are made with the knowledge that willful false statements are punishable by fine or imprisonment, or both, under § 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the patent application or any patent issued thereon.

Date: 9/28/06

By



David R. Jones, IV